

R E M A R K S

Claim 1 has been amended to define the masking member as a member

"used to protect a bolt hole with a part around the periphery of said hole on which a washer is put or to protect a harness hole with a part around the periphery of said hole on which a stand of a plug of said harness hole is put, said part around the periphery of said bolt hole having a corresponding shape fitting exactly to the shape of said washer and said part around the periphery of said harness hole having a corresponding shape fitting exactly to the shape of the stand of the plug"

and made of a foamed polystyrene *panel*, and, after the recitals of panel expansion ratio and groove arrangement and dimensions, to state

"so that when said masking member is snapped along said groove or grooves, the edge of said masking member along said groove or grooves becomes substantially straight."

These amendments are supported by the disclosure in the original specification at paragraphs [0037], [0041] and [0045].¹

Claim 5 has also been amended, to correct a minor typographical error.

¹References are to numbered paragraphs in applicants' U.S. Patent Application Publication No. 2005/0221055 A1.

Since the present Amendment does not increase either the total number of claims or the number of independent claims, no additional fee is necessary.

Claims 1 (independent; amended) and 4 - 8 (all directly or indirectly dependent on claim 1) are in the application. No claim has been allowed.

Claims 1 and 4 have been rejected under 35 U.S.C. §103(a) as unpatentable over each of U.S. patents No. 4,835,026 (Horiki et al. '026), No. 5,206,069 (Horiki et al. '069) and No. 4,913,786 (Horiki et al. '786). Claims 5 - 8 have also been rejected under §103(a) as unpatentable over Horiki et al. '786.

With reference to the rejection of claim 1 on the cited art, it may initially be noted that the invention defined by claim 1 as herein amended has the effect that the boundary between the coated part and the uncoated part becomes substantially straight and the edges of the washer or the stand of the plug and the boundary line L of the coating film surrounding the aforesaid uncoated part match, so that the uncoated part is not exposed around the washer or the stand of the plug.

Horiki et al. '026 and Horiki et al. '069 describe masking members comprising a molded formed polystyrene panel provided with grooves formed on one or both sides of the panel. Nevertheless, these references do not disclose or suggest that the depth of the groove(s) is set to be in the range of between 10 and 70% and the width of the groove(s) is set to be within the range of 0.1 to 5 mm and further the masking member is used to protect the hole and the

part around the periphery of the hole. Again in Horiki et al. '786 there is no teaching or suggestion of applicants' claimed groove depth and width; in particular, the reference does not even address the problem solved by applicants through the provision of their claimed ranges of these dimensions, viz., to make the boundary between the coated part and the uncoated part substantially straight so that the edges of the washer or the stand of the plug and the boundary line of the coating film surrounding the aforesaid uncoated part match, thereby preventing exposure of the uncoated part around the washer or the stand of the plug.

As for Horiki et al. EP 0307932 (EP '932), cited in the Office Action as a "teaching reference" to the fact that polystyrene foams used for masking members commonly have an expansion ratio of 2-50 times, applicants submit that EP '932 discloses a masking member made of polystyrene foam sheet while the present masking member is made of a foamed polystyrene panel, and further, in EP '932 the masking member is not used to protect the hole and the part around the periphery of the hole, and further, EP '932 does not disclose that the depth of the groove(s) is set to be in a range of between 10 and 70% of the panel thickness, and the width of the grooves is set to be within the range of 0.1 to 5 mm.

In light of these considerations, it is submitted that the combination of features recited in claim 1 as herein amended presents a patentable distinction over each of Horiki et al. '026, Horiki et al. '069 and Horiki et al. '786. Claims 4 - 8 are submitted to be allowable as well, by virtue of their dependence on claim 1.

For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

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